



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,818	12/13/2001	Ronald W. Davis	25436/1652	5874
27495	7590	12/28/2004	EXAMINER	
PALMER & DODGE, LLP KATHLEEN M. WILLIAMS / STR 111 HUNTINGTON AVENUE BOSTON, MA 02199			SULLIVAN, DANIEL M	
			ART UNIT	PAPER NUMBER
			1636	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,818

Applicant(s)

DAVIS ET AL.

Examiner

Daniel M Sullivan

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-41 is/are pending in the application.
- 4a) Of the above claim(s) 10-23 and 27-29 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-9, 24-26 and 30-37 is/are allowed.
- 6) ☒ Claim(s) 39-41 is/are rejected.
- 7) ☒ Claim(s) 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/15/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office Action is a reply to the Paper filed 20 October 2004 in reply to the Non-Final Office Action mailed 20 April 2004. Claims 10-23 and 27-36 have been withdrawn from consideration and claims 3-9, 24-26 and 37 were considered in the 20 April Office Action. Claim 3 was canceled, claims 24, 25 and 27 were amended and claims 38-41 were added in the 20 October Paper. Claims 4-41 are pending.

Election/Restrictions

Claims 4 and 5 are directed to an allowable product. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claims 30-36, directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, are now subject to being rejoined. Process claims are hereby rejoined and fully examined for patentability under 37 CFR 1.104. In accordance with the Official Gazette notice, *supra*, process claims 27-29, which do not depend from or otherwise include all the limitations of the allowable product, have NOT been rejoined. It is noted that although claim 29 depends from claim 26, this is presumed to be a typographical error as claim 26 is not a method and does not comprise an "introducing step (a)" as recited in claim 29.

Claims 4-9, 24-26 and 30-41 are under consideration.

Information Disclosure Statement

The information disclosure statement filed 15 November 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each publication or that portion which caused it

Art Unit: 1636

to be listed; and all other information or that portion which caused it to be listed. Specifically, the "Copy of the Supplemental Partial European Search Report (EP01991178)", listed as item 3 on the Form 1449, is not present in the file. As the reference has not been considered, its citation has been lined through on the Form. The other references have been considered.

Response to Amendment

Claim Rejections - 35 USC § 102

Rejection of claims 3-9 and 37 under 35 U.S.C. 102(b) as being anticipated by von Arnim *et al.* (1998) *Gene* 221:35-43 as evidenced by Swiss-Prot Database Entry P42212 is withdrawn in view of the amendments and arguments presented in the 20 October Paper.

New Grounds Necessitated by Amendment

Claim Objections

Claims 38 and 41 are objected to because the claim sets forth sequence data without accompanying SEQ ID NOs. 37 CFR 1.821(d) states, "[w]here the description or claims of a patent application discuss a sequence that is set forth in the 'Sequence Listing' in accordance with paragraph (c) of this section, reference must be made to the sequence by use of the sequence identifier, preceded by 'SEQ ID NO:' in the text of the description or claims, even if the sequence is also embedded in the text of the description or claims of the patent application."

It is further noted that each amino acid sequence of greater than 4 amino acids must be represented in the sequence listing, including polypeptides comprised of multimers of less than 4

Art Unit: 1636

amino acids (*e.g.*, (Glu-Lys)₃). Applicant should amend the sequence listing to properly represent each of the sequences disclosed in the application.

Applicant is advised to contact Mark Spencer at (571) 272-2533 with any questions regarding a proper sequence listing in the present case.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 39-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 39 is indefinite in using the conjunction “and” in line 4 of part (d), indicating that the third polypeptide comprises all of the proteins set forth in the list. It is recommended that the conjunction “or” be used instead of “and” or that the claim be amended to recite “selected from the group consisting of” in accordance with proper Markush claim language.

Claims 40 and 41 are indefinite insofar as they depend from claim 39.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1636

Claim 39 is rejected under 35 U.S.C. 102(b) as being anticipated by Bulinski (November 1999) US Patent No. 5,989,577.

The claim is directed to a recombinant fusion polypeptide comprising a first, second and third polypeptide, wherein the first and second polypeptides, which are monomers of a multimeric fluorescent protein and are not fluorescent donor and acceptor to each other, are bonded via a linker sequence and the third polypeptide comprises a structural protein. Bulinski teaches a GFP trimer, which, as discussed in previous Office Actions meets the limitations of first and second polypeptides that are monomers of a multimeric fluorescent protein and are not fluorescent donor and acceptor to each other joined by a linker (*i.e.*, the middle GFP protein). The polypeptide of Bulinski further comprises the MT-binding domain of Ensconsin, which anticipates the structural protein as described in the first full paragraph on page 27 of the specification. Thus, Bulinski teaches a polypeptide comprising each of the limitations of the instant claim 39. Therefore, the claim is properly rejected under 35 USC §102(b) as anticipated by the art.

Allowable Subject Matter

Claims 4-9, 24-26 and 30-37 are allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1636

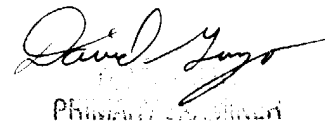
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel M Sullivan whose telephone number is 571-272-0779. The examiner can normally be reached on Monday through Thursday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel M. Sullivan, Ph.D.
Examiner
Art Unit 1636



Daniel M. Sullivan